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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,754	10/03/2005	Naohiko Ichihara	Q90576	4338
23373 7590 08/09/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER GOLDFARB, JONATHAN A	
			ART UNIT 3663	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/551,754

Applicant(s)

ICHIHARA ET AL.

Examiner

Jonathan Goldfarb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 1-36, 41, 43-46, 49-51, 55-57, 59, 63-67 and 70-72 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-40, 42, 47, 48, 52-54, 58, 60-62, 68 and 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant elected Species A and Group I for examination, which includes claims 37-40, 42, 47, 48, 52-54, 58, 60-62, and 68-69 in the reply filed on 17 July 2007.
2. The remaining claims are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 17 July 2007.
3. Applicant's election with traverse of Group I and Species A in the reply filed on 17 July 2007 is acknowledged. The traversal is on the ground(s) that there was unity shown in the International Search Report at the PCT stage, and the invention was therein found to have novelty over two prior art references. This is not found persuasive because as delineated in the election request, the instant claims cover an impermissible combination of categories, and in addition, the references listed as "Y" in the ISR prove the lack of novelty.

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/551,754, filed on 03 October 2005.

***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Navigation System with Route Data Including Date/Time Function.

4. The abstract of the disclosure is objected to because of the length and syntax. Correction is required. See MPEP § 608.01(b).

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

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disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 54 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The addition/deletion determination device and decision device operate "on the basis of" inputs, but it is not clear how these elements operate. A more detailed explanation is needed.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The a) statements of intended use or field of use (i.e. "which obtains" "which stores" "which notifies" etc.), or b) "wherein" clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if

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the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2d 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim. This applies to claims elected.

12. Claims 37-40, 42, 47 rejected under 35 U.S.C. 103(a) as being unpatentable over Hiyokawa (US 5,931,888) and further in view of Takayama et al. (US 2001/0020211). Hiyokawa discloses a navigation apparatus comprising elements a-b, d, f (see below). However, Hiyokawa is silent regarding spot data and route data generation as per the instant application. Takayama et al. teaches these elements c and e (see below):

- a. A departure point data acquisition device [H-ref., Fig. 4 and related text],
- b. A destination registration device [H-ref., Fig. 4 and related text],
- c. A spot data acquisition device including (end point, stay time, available time (data and time)) [T-ref., Fig.s 1B and 41 and related text; 0143],
- d. A storage device [H-ref., Fig. 4 and related text],
- e. A generation device of route data including ETA (start and end points and map data) [T-ref., abstract; Fig.s 1A and 41 and related text; 0143],
- f. A route guidance device [H-ref., abstract].

Regarding claim 38, the generation device (claim 37e) generates a route from the start point to multiple destinations [T-ref., 0006; 0013; etc.].

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Regarding claim 39, the apparatus of claim 37, further comprising a notification device [T-ref., abstract; Fig. 41 and related text].

Regarding claim 40, wherein the destination information may include a name, departure time, and/or stay length [T-ref., abstract, Fig.s 1B and 41 and related text; 0143], and the notification device notifies about the name, expected arrival/departure time, and/or stay length [T-ref., abstract, Fig.s 1B and 41 related text; 0143].

Regarding claim 42, wherein the generation device comprises:

- a. A required time computation device [H-ref., col. 9, line 31-col. 10, line 15],  
and
- b. A route generation device based on the time in a. [H-ref., col. 9, line 31-col. 10, line 15].

Regarding claim 47, wherein the spot data device obtains genre info [T-ref., Fig. 1B and 41 and related text; 0143; 1039; 1044] and stay length info based on the genre [T-ref., Fig. 1B and 41 and related text; 0143; 1039; 1044].

Regarding claim 48, the apparatus according to claim 37, further comprising a time setting device to set the stay length [T-ref., Fig. 1B and 41 and related text; 0143], wherein the spot data device receives the stay length when it receives the spot data [T-ref., Fig. 1B and 41 and related text; 0143].

Regarding claim 52, wherein where said navigation apparatus comprises:

- a. A present position device [H-ref., Fig. 4 and related text],
- b. A predicted arrival time device [T-ref., Fig. 41 and related text],



- c. A regeneration device [T-ref., abstract; Fig.s 1A and 41 and related text; 0143],

Regarding claim 53, wherein the regeneration device comprises:

- a. A time difference computation device (between expected arrival time and predicted arrival time) [T-ref., Fig. 41 and related text],
- b. A regeneration determination device based on a. [T-ref., abstract; Fig.s 1A and 41 and related text; 0143],
- c. A route regeneration device [T-ref., abstract; Fig.s 1A and 41 and related text; 0143].

Regarding claim 54, wherein the regeneration determination device comprises:

- a. An addition/deletion determination device regarding waypoints [col. 2, lines 24-35], and
- b. A decision device regarding regenerating the route to the waypoint of a. [T-ref., abstract; Fig.s 1A and 41 and related text; 0143].

Regarding claim 58, wherein where the navigation apparatus comprises:

- a. A present position device [H-ref., Fig. 4 and related text],
- b. A travel time device [H-ref., col. 9, line 31-col. 10, line 15],
- c. A detection device regarding counting down remaining trip time [T-ref., inferred by 0012],
- d. A presentation device regarding the destination as related to c. [Fig. 4 – display],

Regarding claim 60, the navigation apparatus according to claim 52, further comprising the notification device, wherein, the notification device notifies the route data is generated [T-ref., abstract; Fig. 41 and related text].

Regarding claim 61, the apparatus according to claim 60, further comprising a regeneration selection device regarding selection of performing route guidance, wherein the regenerated route data is used [T-ref., abstract; Fig.s 1A and 41 and related text; 0143].

Regarding claim 62, wherein the navigation apparatus further comprises:

- a. A present position device [H-ref., Fig. 4 and related text],
- b. A distance computation device [H-ref., inferred from Fig. 2 and related text],
- c. A distance determination device [H-ref., Fig. 2 and related text],
- d. A presentation device [Fig. 4 – display].

Regarding claim 68, a server apparatus in a navigation system, the server comprising:

- a. A reception device [inherent],
- b. A spot data device [T-ref., 0038],
- c. A storage device [inherent],
- d. A generation device [inherent].

Regarding claim 69, the server apparatus wherein it comprises:

- a. A present position device [H-ref., Fig. 4 and related text],
- b. A predicted time computation device [T-ref., Fig. 41 and related text],

- c. A regeneration device [T-ref., abstract; Fig.s 1A and 41 and related text; 0143].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the spot data device of Takayama et al. with the navigation apparatus of Hiyokawa so that the aforementioned navigation system will work more effectively by providing a better navigation system for a vehicle that includes the above elements.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Goldfarb whose telephone number is 571-272-7964. The examiner can normally be reached on M-Th 9-5, F ~2.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

02-Aug-07



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SUPERVISORY PATENT EXAMINER